

## REMARKS

Reconsideration of the subject application in view of the present amendment is respectfully requested.

By the present amendment, Claims 1, 2, and 4 have been amended.

Based on the foregoing amendments and the following remarks, the application is deemed to be in condition for allowance, and action to that end is respectfully requested.

### **I. Rejection of Claims**

#### **Ia. Rejection under 35 U.S.C. § 112**

The Examiner rejected claims 2-4 under 35 U.S.C. § 112, second paragraph, for allegedly being indefinite. It is respectfully submitted that the foregoing amendment of claims 2 and 4 eliminates the alleged indefiniteness therein.

#### **Ib. Rejection Over the Prior Act**

The Examiner rejected Claim(s) 1 through 3 under 35 U.S.C. § 102(b) as being anticipated by or, alternatively, under 35 U.S.C. § 103(a) as being unpatentable over Obergfell, U.S. Patent No. 3,850,359 (Obergfell). Claims 4-6

were rejected under 35 U.S.C. § 103(a) as being unpatentable over Obergfell in view of Hirai et al., U.S. Patent No. 6,220,496 (Hirai).

It is respectfully submitted that claims 1-6 are patentable over the cited references. Specifically, claim 1 recites that the electrically driven device (5) for pre-compressing is located in the tool housing (10).

Locating the pre-compressing device in the tool housing facilitates handling of the tool and makes the tool more flexible in application.

In Obergfell, the compressor (42) is located outside of the tool housing (tool handle 80).

A rejection based on 35 U.S.C. § 102 as in the present case, requires that the cited reference disclose each and every element covered by the Claim. Electro Medical Systems S.A. v. Cooper Life Sciences, 32 U.S.P.Q. 2d 1017, 1019 (Fed. Cir. 1994); Lewmar Marine Inc. v. Barient Inc., 3 U.S.P.Q. 2d 1766, 1767-68 (Fed. Cir. 1987); Verdengaal Bros., Inc. v. Union Oil Co., 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987). The federal Circuit has mandated that 35 U.S.C. § 102 requires no less than “complete anticipation … [a]nticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim (emphasis added)”. Connell v. Sears, Roebuck & Co., 220 U.S.P.Q. 193,

198 (Fed. Cir. 1983); See also, Electro Medical Systems, 32 U.S.P.Q. 2d at 1019; Verdegaal Bros., 2 U.S.P.Q. 2d at 1053.

Clearly, in Obergfell, the pre-compressing means (42) is not arranged as in Claim 1. Accordingly, since Obergfell fails to disclose each and every feature of independent Claim 1, Obergfell , as a matter of law, does not anticipate the present invention, as defined by said independent claim.

In view of the above, it is respectfully submitted that Obergfell does not anticipate or make obvious the present invention as defined in Claim 1, and the present invention is patentable over Obergfell.

Claims 2-6 depend on Claim 1 and are allowable for the same reasons Claim 1 is allowable and further because of specific features recited therein which, when taken alone and/or in combination with features recited in Claim 1 are not disclosed or suggested in the prior art.

## **CONCLUSION**

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order

to place the case in condition for final allowance, it is respectfully requested that such amendment or correction be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

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